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P.O BOX 1450  
ALEXANDRIA, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

Jennifer H. Hamilton  
THE ECLIPSE GROUP  
10453 Raintree Lane,  
Northridge, CA 91326

27 JAN 2006

In re Application of	:	DECISION ON
Orler et al	:	
PCT No.: PCT/US2003/019363	:	
Application No: 10/518,621	:	
Int. Filing Date: 18 June 2003	:	PETITION UNDER
Priority Date: 20 June 2002	:	
Attorney's Docket No.: ST02017USU3 (141-US-U3)	:	
For: GENERIC SATELLITE POSITIONING ...	:	
SELECTABLE INPUTS AND OUTPUTS	:	37 CFR 1.47(a)

This is in response to the "Declaration of Francisco A. Rubio-Campos" filed on 25 October 2005, which is being treated as a petition under 37 CFR 1.47(a). The petition fee of \$200.00 has been charged to Deposit Account Number 502542 as stipulated in the petition transmitter letter.

**BACKGROUND**

On 18 June 2003, petitioner filed international application PCT/US2003/019363, which claimed priority to an earlier application filed 20 June 2002. The thirty-month (30) time period for paying the basic national fee in the United States of America expired at midnight on 20 December 2004.

On 20 December 2004, petitioner filed in the United States Patent & Trademark Office a transmittal letter for entry into the national stage in the U.S. under 35 U.S.C. 371, which was accompanied by, inter alia, the U.S. basic national fee. No executed oath or declaration accompanied the above papers.

On 05 May 2005, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) which informed applicant, inter alia, that an "Oath or Declaration of the inventors, in compliance with 37 CFR 1.497(a), and (b), identifying the application by International application number and international filing date. The notification stated that the current oath or declaration, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date, and that a \$65 surcharge for providing the oath or declaration later than 30 months from the priority date (37 CFR 1.492(e)) is required.

On 25 October 2005, petitioner filed the present petition, a declaration by Francisco A. Rubio-Campos in support of filing on behalf of omitted inventor Keith Jacob Brodie accompanied, *inter alia*, an executed Declaration without the signature of Keith Jacob Brodie.

## DISCUSSION

### **PETITION UNDER 37 CFR 1.47(a):**

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Furthermore, section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.) **Proof of Unavailability or Refusal**, the relevant sections states, in part:

### **REFUSAL TO JOIN:**

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part

of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the **37 CFR 1.47** applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Petitioner has satisfied requirements (1) and (3) - (4) of **37 CFR 1.47(a)** but not requirement (2).

Regarding requirement (1), petitioner has provided the fee under **37 CFR 1.17(g)**.

Regarding requirement (2), Mr. Rubio-Campos' declaration states that on or about August 19, 2005, the firm sent an e-mail to inventor Keith Jacob Brodie that he sign and return the Combined Declaration and Power of Attorney, and that his response was that he would sign the documents once he received the money.

However, it has not been sufficiently demonstrated that a copy of the application papers were presented to the nonsigning inventor. It is unclear what documents were forwarded to Mr. Brodi because Mr. Rubi-Campos' statement only discusses the declaration and does not refer to a copy of the application papers (specification, including claims, drawings, and oath or declaration) as required under MPEP. 409.03(d) being sent to him. In addition, no documentary evidence to support this assertion has been provided such as a registered returned envelope, a certified mail return receipt, etc..., to show that the letters were sent to Mr. Brodi or the e-mail response by Brodie. Consequently, it is unclear if he actually received the documents.

Moreover, it is not clear from the petition that it was Mr. Rubio-Campos who performed the items listed in paragraph 5 of his declaration, and has first hand knowledge of those facts as required by MPEP Section 409.03(d). If Mr. Rubio-Campos was not the person who performed the actions listed in paragraph 5, petitioner will need to submit statements, with specific facts on the actions referred to by paragraph 5 by person(s) who has first-hand knowledge of such facts.

Accordingly, the steps enumerated by Mr. Rubio-Campos are not sufficient to establish that Mr. Brodie has refused to sign the declaration.

Regarding requirement (3), although petitioner has provided a statement of the last known address of the missing inventor.

Regarding requirement (4), petitioner has provided an executed declaration signed by Mr. Orler, and Mr. Norman on their behalf and on the behalf of the nonsigning joint inventor Keith Jacob Brodie.

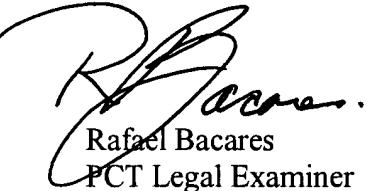
Consequently, the petition does not satisfy all the requirements under 37 CFR 1.47(a).

### CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration of the merits of the petition under 37 CFR 1.47(a) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time are available under 37 CFR 1.136(a). Failure to timely file the proper response will result in ABANDONMENT.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Rafael Bacares  
PCT Legal Examiner  
PCT Legal Office  
Telephone: (571) 272-3276  
Facsimile: (571) 273-0459